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Appeals
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REISSUE APPLICATION S/N 09/241,825

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mark Lyte

Examiner: H. Lilling

Serial No.: 09/241,825

Group Art Unit: 1651

Filed: February 1, 1999

Docket: 933.001USR

Title: COMPOUNDS FOR MODULATING GROWTH OF INFECTIOUS AGENTS

SUPPLEMENTAL APPEAL BRIEF TO THE BOARD OF
PATENT APPEALS AND INTERFERENCES OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

BOX APPEALS

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This is a Supplemental Brief an appeal from the Office Action (Advisory Action) mailed on July 14, 2000 and the Office Action (Final Rejection) mailed March 24, 2000, finally rejecting claims 23-42. Claims 1-2, the original claims in the Patent from which this Reissue was filed, are still allowed. The Supplemental Brief is required by order of the US Patent and Trademark Office Board of patent Appeals and Interferences in response to the **ORDER** MAILED February 28, 2002. That order required Appellant to respond to clarify issues on the Appeal in view of a new decision, Pannu v. Storz Instruments, Inc., 258 F.3d 1399, 59 USPQ2d 1597 (Fed. Cir. 2001), which was decided on July 25, 2001.

The **ORDER** indicated that the Pannu decision discussed the recapture rule in a manner that might directly impact the present Appeal. The **ORDER** specifically interpreting the case as stating that:

“...[o]n reissue, [patentee] is estopped from attempting to recapture the precise limitation [patentee] added to overcome the prior art rejections.” 258 F.3d at 1372, 59 USPQ2d at 1601.

This Supplemental Brief is being filed in triplicate. **Appellants request the opportunity for a personal appearance before the Board of Appeals to argue the issues of this appeal.** The fee for the personal appearance has been timely paid after receipt of the Examiner's Answer.

The Holding in the Pannu case

In the prosecution of a Reissue Application of U.S. Patent No. 4,435,855, Patentees specifically attempted to broaden the scope of the term "haptics" in claims in the Reissue Application. The term 'haptics' was not only defined by specific limitations in the claims, but those specific limitations had been added during prosecution to avoid prior art, and those defining terms were specifically argued during prosecution of the original patent to have been the basis for distinguishing over the prior art. The Court properly held that:

"In prosecuting the '855 patent, Pannu specifically limited the shape of the haptics to a 'continuous, substantially circular arc.' On reissue, he is estopped from attempting to recapture the precise limitation he added to overcome prior art rejections."

The Fact Background in the Present Reissue Application

The prosecution history leading to the original Lyte Patent (U.S. Patent No. 5,629,349) was extremely involved, and covered an original application (USSN 07/730,485), a first continuation-in-part application (USSN 07/753,709), a second continuation-in-part application (USSN 07/847,196) and a continuation application (USSN 08/266,805). The issue in the Pannu case can be resolved by looking backwards in the prosecution history to see what was ultimately surrendered by amendment during prosecution, as if claims had been originally narrowed in earlier applications, then restated in broad terms in later applications, the earlier narrowing effects of amendments could not apply under the Pannu decision. It is the sound position of Appellants that, when broad claims are reinstated in a pending application, earlier amendments have no basis for analysis of surrender. Applicants are allowed, without prejudice, to narrow and broaden claims during prosecution. 37 CFR 1.111(a) places no limitation on the nature and type of Amendments, except that there must be antecedent basis in the original application for the content of the claims (35 USC 112, first paragraph and 35 USC 132). The issue in Pannu must therefore be limited to the last stream of Amendments in the application, the reason for the amendments, and the scope of those Amendments. The history shows:

- 1) On December 25, 1992, a rejection of claim 1-23 was made.
- 2) In response to that rejection, claims 1-23 were cancelled and new claims 24-33 were added. Those claims (especially claims 29-32) included subject matter compatible with stimulation of the growth of bacteria.
- 3) Claims 24-33 were then subjected to a restriction requirement on April 23, 1993.
- 4) In response to the restriction requirement, the attorney of record elected claims 24 and 15.
- 5) In an Office action mailed October 13, 1993, claims 24-25 were rejected.
- 6) A continuation application (as identified above on June 27, 1994) was filed, along with a Preliminary Amendment.
- 7) The critical issue at this point is that the original continuation application, U.S. Serial No. 08/266,805 was filed (as shown on the attached Filing receipt), with 20 claims, including the original claims with their scope directed towards
- 8) The preliminary amendment was made completely voluntarily (albeit adversely to the interests of Applicant, which is why this Reissue has been filed). **The Preliminary Amendment** was not made in response to any rejection of record in the Continuation Application. Whatever the reasons for the Preliminary Amendment, that Amendment does not fall under the aegis of the Pannu case. The amendments were not made in response to a rejection in that Application.
- 9) The Pannu case provides no controlling authority over this Reissue Application.

SUMMARY OF THE ARGUMENTS

The basic issues raised in this Appeal still revolve around the question of whether a Reissue Application allows Appellant to claim the subject matter recited in claims 23-42. The basic arguments against allowing the claims are not based upon any issue of Novelty under 35 USC 102 or Obviousness under 35 USC 103. All arguments relate to technical issues unique to Reissue Practice. Those issues may be summarized as follows, with Appellant's position stated thereafter.

1. The rejection asserts that Applicant abandoned the subject matter of the claims on Appeal.

The rejection and the record have failed to appreciate the fact that a broadening Reissue Application allows Applicants to claim subject matter narrower in scope than the subject matter abandoned during the prosecution of the original patent. That issue, though repeatedly raised, has never been the subject of a response on the issue by the U.S. Patent and Trademark Office. The reason there has been no response is that every claim on Appeal is narrower in scope than any claim cancelled during prosecution of the last application, where that claim encompassed the subject matter of the claims in this Appeal. The claims on this Appeal are therefore in strict compliance with the regulations and provisions of broadening reissue practice.

The rejection is clearly in error and must be withdrawn. Applicant may be held to have abandoned an invention broader than the claims on Appeal, but the narrower claims on Appeal are consistent with the broadening Reissue practice of the U.S. Patent and Trademark Office.

3. Applicant never intended to claim the subject matter on Appeal in the prosecution of U.S. Patent No. 5,629,349.

Appellant cannot comprehend the basis for this assertion. The title, the disclosure and the original claims in every application in the series of application included claims to the modulation of growth. This is pointed out in detail below. It was because of error and mistake in the prosecution of the Patent that inadequate protection of the actual invention of the specification and original claims was not achieved.

Any reading of the claims originally filed in the application that issued as U.S. Patent No. 5,629,349 will show an intent to claim an invention generic to both enhancement and suppression of bacterial growth and viral growth. Evidence was actually introduced in the form of a letter from the inventor to prior counsel showing a lack of comprehension on why the scope of the claims was being diminished. This evidence was submitted at the specific request of the Examiner. In spite of this clear record, the rejection remains that Appellant never intended to

claim subject matter generic to the subject matter of the claims on Appeal. This assertion is clearly in error, and this will be shown in detail in the discussions and arguments below.

DETAILED ARGUMENTS OF APPELLANT

The rejections and issues in the Application are as follows:

FACTOR I. Abandonment of Claimed Subject Matter Based on the Instant File History

A) It is asserted the file history shows that Applicant Lyte "...had **ABANDONED** any inventions pertaining to the enhanced growth of bacteria and harvesting by-products based on the file history of Application Ser. No. 08/266,805...The first action in this Application was a restriction submitted on March 01, 1995 as noted below:..."

B) The Examiner then points out that **at the time of the restriction requirement, only claims 24 and 25 and claims 26-28 were present in the application.** Both of these sets of claims are drawn towards suppressing the growth of gram positive or gram negative organisms.

C) The Examiner also notes that the final rejection was based upon issues solely relating to formal issues under 35 U.S.C. 112, first and second paragraphs.

D) Based on this record, the Office Action mailed March 24, 2000 asserts that "...**(D)uring** prosecution of the claims under consideration at that time including generic claims **were abandoned** due to the rejections by the Examiner.

E) It is asserted that "No restrictions were submitted based on the generic claim that was found not to be allowable. Applicant Lyte had effectively abandoned the generic claim in view of the claims submitted in Serial No. 08/266,805."

F) From September 13, 1992 to May 12, 1997, Applicant Lyte had the opportunity prior to the issue of the patent to submit claims covering "the important invention of enhancing the growth of bacteria and viruses and harvesting by-products of the bacterial and virus."

G) Applicant is offered the opportunity to submit evidence on the record that he did not abandon the claimed subject matter by presenting certified copies of the alleged 'clear instructions and explanations that I gave the attorney.'

H) Although the following issues do not relate clearly to the subject issue of the abandonment of the invention, the Examiner also asserts in this grouping of issues that "...the issue of the claimed subject matter to a **different invention** based on the record involves a lack of diligence on the part of Applicant to submit an application to the different and patentably distinct subject matter and the abandonment of the claimed subject matter which subject matter was not present in the original **patented application** for the alleged generic claim." (Emphasis natural).

I) Applicant is asserted to not be within the guidelines of Section 251 that there was an error within the meaning of "recapture rule" based on the history and the patented claims under consideration....Applicant's failure to timely file another application to the claimed subject matter is not considered to be an error causing a patent granted on examined claims to be partially inoperative by claiming less than the applicant had a right to claim. Thus applicant's error is not correctable by reissue of the original patent under 35 U.S.C. 251.

FACTOR 2 Reissue Applications - DIFFERENT INVENTIONS

A) The new claims 23-42 are "drawn to an invention which is not considered to conform to the same general invention as the original patent. That is, claims 23-42 are drawn to patentably distinct inventions....Claims 1-2 are drawn to a method of suppressing the growth of...bacteria..."(Claims 3-11 [now claims 23-31] which inventions are **directly opposite** to claims 23-32 which are drawn to "**enhancing the growth of bacteria.**"

B) In addition it was asserted that there was no search and examination of any aspect to any methods of enhancing the growth of bacteria. As enhancing the growth cannot conform to the issued claims of suppressing the growth of bacteria, the present claims do not conform to the subject matter of the general invention elected and allowed in the original application.

C) These patentably distinct inventions (claims 23-42) "**would have been restricted**" along with the other inventions as set forth in the restriction election in the Office action of 31 January 1995, had they been presented at that time. Accordingly, claims 23-42 stand withdrawn from further consideration on the merits.

FACTOR 3 - LACK OF INTENT TO CLAIM THE SPECIES NOW CLAIMED IN THE REISSUE

It is asserted that claims 23-42 are rejected under Section 251 as containing claims to different inventions that were not submitted in the original patent, U.S. 5,629,349. The Office Action then cites the MPEP and case law to the effect that:

A) In situations where a reissue applicant presents claims for the first time that are distinct and separate from the claims of the patent, the examiner must follow the practice resulting from In re Amos, 953 F.2d 613 [and not offer a restriction requirement].

B) A reissue applicant's failure to file a divisional application is not considered to be error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim.[citing three cases, at least one of which was previously cited by applicant].

C) Likewise, if the original patent specification shows an intent not to claim the newly presented invention, that invention cannot be added by reissue. "If the reissue application presents claims to species not claimed in the original patent, election of species should not be required, but the added claims may be rejected, where appropriate, for lack of defect in the original patent and lack of error in obtaining the original patent as discussed above."

SUMMARY OF THIS APPEAL

Each and every issue raised in the Office Action has been fully addressed and traversed in this Brief On Appeal. The Examiner and the Board of Appeal are earnestly requested to review the content of the "**DECLARATION FOR BROADENING REISSUE APPLICATION**" filed with the original Reissue Application. That declaration more thoroughly discusses the issues raised in this Office Action and Briefs the issues with respect to the law and Patent Rules. Applicant incorporates those comments herein, rather than merely repeating them.

CONCLUSION

All rejections of record have been shown in detail to be in error. The rejection should be reversed and all claims should be indicated as allowable.

Applicants believe the claims are in condition for allowance and request reconsideration of the application and allowance of the claims. The Examiner is invited to telephone the below-signed attorney at 952.832.9090 to discuss any questions that may remain with respect to the present application.

Respectfully submitted,

MARK LYTE

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Box AF, Assistant Commissioner of Patents, Washington, D.C. 20231 on April 16, 2002.

Name *MARK A. LITMAN*


Signature

Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTORNEY DOCKET NO.	DRWGS	TOT CL	IND CL
08/266,805	06/27/94	1802	\$355.00	910159.CCP	15	20	3

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Receipt is acknowledged of this patent application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Application Processing Division's Customer Correction Branch within 10 days of receipt. Please provide a copy of the Filing Receipt with the changes noted thereon.

Applicant(s) MARK LYTE, MANKATO, MN.

CONTINUING DATA AS CLAIMED BY APPLICANT-
THIS APPLN IS A CON OF 07/847,196 03/06/92
WHICH IS A CIP OF 07/753,709 09/03/91 ABN
WHICH IS A CIP OF 07/730,485 07/16/91 ABN

* SMALL ENTITY *

TITLE
COMPOUNDS FOR MODULATING GROWTH OF INFECTIOUS AGENTS

PRELIMINARY CLASS: 435